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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,128	06/30/2000	GRAHAM FRANCOIS DUIRS	08059-0001	2910
22852	7590	04/29/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			DEVORE, PETER T	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Sp

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/529,128	DUIRS, GRAHAM FRANCOIS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter T deVore	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 14 and 18 is/are rejected.
- 7) ☒ Claim(s) 13, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-9, 12, 14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Klatt.

The Klatt reference discloses a substance delivery device that is for internal insertion at least least partially into a body cavity i.e.the nasal passages comprising a support frame having two resilient arms (see Figures in Klatt reference showing frame and arms and see claim 3 of Klatt which describes the member as resilient), and releasably receivable substance delivery means on each arm (see Klatt Figure I). Note that as the arms are resilient, they can be considered "biased outward" because they would inherently tend to exert outward forces when they are pushed towards each other due to their resiliency, and likewise can be considered "biased inward" because they would inherently tend to exert inward forces when they are pushed away from each other due to their resiliency. Regarding claim 2, see Klatt column 1, lines 8-20. Regarding claim 5, note rounded delivery means 5. Regarding claims 6 and 7, see Klatt Figure VII. Regarding claim 9, see Klatt Figure IV. Regarding claim 12 the arms are inherently capable of being pushed towards each other due to their resiliency and in this configuration the device can be considered "effectively compressed". Regarding claims 14 and 18, see the portion of the support frame proximate reference numeral 12 in Klatt Figure VII.

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Millar.

The Millar reference discloses an intra-vaginal release device comprising a support frame (proximate reference numeral 3 in Millar Figure 1), support arms (proximate reference numerals 2 and 4 in Millar Figure 1), and releasably receivable substance delivery means on each arm (see rubber substance delivery means on arms in Klatt Figure 3). Regarding claim 2, see Millar column 1, lines 9-24. Regarding claim 4, see Millar column 2, lines 55-62. Regarding claim 5, see Millar Figure 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klatt.

The Klatt reference discloses a device as discussed supra, but does not disclose that the frame is made of nylon. However, it would have been obvious to make the frame from nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *Re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

Applicant's arguments filed 3/11/05 have been fully considered but they are not persuasive. Applicant first argues that the Klatt device is not retained in a body cavity. However, as discussed above the Examiner considers a nasal passage to be a body cavity. Applicant next argues that the arms of the Klatt device are not biased outwardly. However, as discussed above the Examiner considers the arms of the Klatt device to be inherently biased outwardly because they are resilient.

### ***Allowable Subject Matter***

Claims 13, 17, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter T deVore whose telephone number is (571) 272-4884. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pd Pd

Peter J. Silva